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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/692,065	10/19/2000	Jae-Hong Park	A33631	7059
21003	7590	07/16/2004	EXAMINER FERGUSON, KEITH	
BAKER & BOTTS 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			ART UNIT 2683	PAPER NUMBER 12

DATE MAILED: 07/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/692,065

Applicant(s)

PARK ET AL.

Examiner

Keith T. Ferguson

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) 28-47 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21-27 is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☒ Claim(s) 12-20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2683

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Terasawa in view of Dahlman et al..

Regarding claims 1 and 9, Terasawa discloses a method (fig. 3) for processing a synchronous message at an asynchronous radio network in an asynchronous mobile Communication system including an asynchronous mobile station and the asynchronous radio network (asynchronous base station) (paragraph 0033, paragraph 0034 and paragraph 0072 line 1 through paragraph 0074 line 3), the method comprising the steps of: a) when a synchronous core network (synchronous base station) is interlocked with the asynchronous radio network (paragraph 0033 and paragraph 0034), generating a system information block (PN sequences) based on header information (information provided on a broadcast channel) provided from the synchronous core network (base station 40B) (paragraph 0035; paragraph 0036 and paragraph 0039 line 1 through paragraph 0043 line 6) b) formatting the generated system information block into a system information message (neighbor list) (paragraph 0035; paragraph 0036 and paragraph 0039 line 1 through paragraph 0043 line 6). Terasawa differs from claim 1 of the present invention in that it does not explicit disclose transmitting the system information message to the asynchronous mobile station via a predetermined channel. Dahlman et al.

Art Unit: 2683

teaches a base station controller that directs a base station to transmit system information message (neighbor list) to a asynchronous mobile station via a predetermined channel (dedicated control channel) (col. 5 line 50 through col. 6 line 35 and col. 7 line 55 through col. 8 line 8). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Terasawa with transmitting the system information message to the asynchronous mobile station via a predetermined channel in order for the remote unit to synchronize itself with the synchronous base station in case of a handoff connection, as taught by Dahlman et al..

Regarding claim 2, Terasawa discloses the predetermined channel is a broadcast control channel (paragraph 0035 lines 8-12).

Regarding claim 3, Terasawa discloses formatting a user zone identification (geographical area) message that is used in a synchronous system into the system information block (neighbor list) (paragraph 0056).

Regarding claim 4, Terasawa discloses classifying the user zone identification message into first information related to a radio resource (Table III) and first information unrelated to the radio resource (table III B.S. ID 46 and 48) (paragraph 0057).

Regarding claim 5, Terasawa discloses the system information block is generated based on the first information unrelated to the radio resource (table III B.S. ID 46 and 48, window size infinity, PN offset) (paragraph 0057).

Regarding claim 6, Terasawa discloses formatting a private (distinct) neighbor list message that is used in the synchronous system into the system information block (paragraph 0050).

Regarding claim 7, Terasawa discloses classifying the private neighbor list message into second information related to the radio resource (B.S. 40A and 40C) and second information unrelated to the radio resource (B.S. 44, 46 and 48) (table III, paragraph 0057).

Regarding claim 8, Terasawa discloses the system

Art Unit: 2683

information block is generated based on the second information unrelated to the radio resource (B.S. 44,46 and 48, PN offset 0 and window size infinity)(table III, paragraph 0057).

Regarding claims 10 and 11, Terasawa discloses classifying the system parameters message into third information (window size) related to the radio resource (paragraph 0056 and paragraph 0057) and third information (window size) unrelated to the radio resource (paragraph 0056 and paragraph 0057).

Allowable Subject Matter

3. Claims 12-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

4. The following is a statement of reasons for the indication of allowable subject matter: Regarding claims 12 and 18, the prior art of record fails to teach or suggest, alone or in combination a wherein the step a) further includes the step of: a4) formatting an extended global service redirection message that is used in the synchronous system into the system information block.

Regarding claim 15, the prior art of record fails to teach or suggest, alone or in combination the step a) further includes the step of: a5) formatting an extended system parameters message that is used in the synchronous system into the system information block.

5. Claims 21-27 are allowed.

6. The following is a statement of reasons for the indication of allowable subject matter: Regarding claim 21, the prior art of record fails to teach or suggest, alone or in combination a method for processing a synchronous message at an asynchronous mobile station in an asynchronous mobile communication system,

Art Unit: 2683

wherein the asynchronous mobile station and an asynchronous radio network are included, the method comprising the steps of: a) receiving a system information block transmitted via a broadcast control channel; b) determining an operating type of a core network; c) when the operating type of the core network is synchronous, selecting the system information block from a system information message; d) analyzing the selected system information block; e) if the selected system information block is related to a message used in a synchronous system, storing information related to the message in a synchronous call control (CC) entity and a synchronous mobility management (MM) entity; and f) if the selected system information block is unrelated to the message used in the synchronous system, storing information related to a radio resource in a radio resource control (RRC) entity.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith T. Ferguson whose telephone number is (703) 305-4888. The examiner can normally be reached on 6:30am-5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (703) 308-5318. The fax phone number for the

Art Unit: 2683

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Keith Ferguson
Art Unit 2683
July 6, 2004

